

REMARKS**I. OVERVIEW**

In response to the Office Action dated May 27, 2003, please enter the following response.

Claims 1-14 are pending in the present application over the traverse of Applicants.

Applicants gratefully acknowledge the Examiner's acknowledgement of Applicants' claim for priority to the earlier filed provisional application and the Examiner's consideration of Applicant's Information Disclosure Statement.

Reconsideration of claims 1-14 is respectfully requested for the following reasons.

II. THE SPECIFICATION OBJECTION

The Examiner has requested that all the claims in the application start on a separate sheet. The original claims are repeated in this response, including claim 1 on a separate sheet. It is respectfully submitted this should remedy the objection. If the Examiner wants Applicants to make a specific amendment to the Specification page 35, Applicants will do so at the Examiner's request.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

All pending claims 1-14 have been rejected as anticipated under 35 U.S.C. § 102(b). This rejection is respectfully traversed.

The Patent Office has the initial burden of making out a *prima facie* case of anticipation. Only thereafter does the burden shift to Applicants to rebut. In re Bass, 177 U.S.P.Q. 178, 186 (CCPA 1973). A *prima facie* case of anticipation requires:

(a) a single reference, (b) that discloses, (c) every limitation of the claim, (d) arranged as in the claim. Lindemann Maschinen Fabrik GmbH vs. American Hoist & Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984).

The basis for the anticipation rejection is set forth beginning at numbered paragraph 4, page 2 of the Office Action through the top of page 4. The Examiner cites to U. S. Patent No. 5,551,880 as the purported single reference that discloses each and every limitation of Applicants' claims in the arrangement of those claims.

Applicants' claim 1 is the sole independent claim in the application. Its preamble recites:

"A method of developing criteria of performance for a job position".

Elements (a) - (c) then set forth specific limitations or steps used in a method "of developing criteria for performance for a job position". Element "(a)" states:

"defining a set of observable behavioral characteristics relevant to a performance in jobs"

This express limitation involves the step of "defining a set of observable behavioral characteristics" as set forth at Applicants' Specification page 9, lines 24-27:

"First, a set or family of characteristics, herein called Competencies, specifically related to observable behaviors in the workplace for most jobs or position is defined."

Step "(b)" of Applicants' claim 1 states:

"Surveying a set of subject matter experts having knowledge or experience relevant to the job to derive how said characteristics relate to the job".

Applicants' Specification, page 9, line 28-31 states:

"Second, one or more persons familiar with the position, and preferably highly performing individuals in the position, are interrogated regarding the set of competencies."

Step "(c)" states:

"defining the job based on said surveying."

As can be seen, the method of claim 1 is (1) a method to try to define what criteria are needed for high performance of a specific type of job, (2) this is done by first defining what characteristics or competencies are relevant to the job, (3) deriving from experts how those defined characteristics or competencies relate to the job based on their knowledge or experience, and (4) defining a job based on the survey.

U. S. Patent No. 5,551,880 ("the '880 patent") discloses a "system for predicting potential of success of an individual for a particular job or task." Abstract, '880 patent. It uses questionnaires with pre-selected questions that probe behaviors and values of the potential employee. Col. 3, line 7 of '880 patent. The individual's answers to the standardized questions are correlated to numerical ratings using an algorithm. Behaviors and values ratings are merged and a report is prepared that is a prediction of the individual's potential success for a job. See '880 patent, Summary of the Invention, page 3, lines 7-65. Therefore, the '880 patent is not a method for defining a job, as set forth in claim 1 of the present application. In direct contrast, it is a method for predicting potential success of an individual for a job.

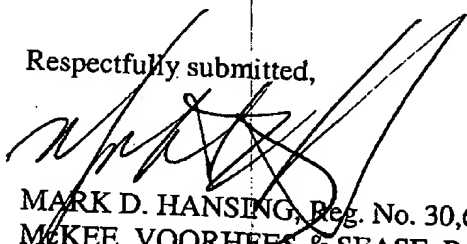
The '880 patent also does not disclose step: "(a)" of applicants' claim 1 -- it does not define a job by the behavioral characteristics or competencies indicated for the job. The present application discusses this difference (see present application Specification page 4, line 11-page 5, line 2; page 14, lines 6-24). It describes how the '880 patent is looking at the individual -- the individual applying for the job (or in the job). The '880 patent discloses gathering information from the individual. An algorithm quantifies the answers and further mathematically merges the quantifications to predict how the individual may perform in the job.

Again, in contrast, present independent claim 1 defines a job by defining a set of observable behavioral characteristics (from potential universe of behavioral characteristics) and surveying subject matter experts on how those characteristics relate to the job. Independent claim 1 has nothing about gathering information from any individual who might be interested in the job. This distinction is noted in Applicants' Specification which notes (a) simply evaluating the skills of a potential applicant is not accurate enough to protect job performance (Applicants' Specification, pages 2-3). Simply evaluating behaviors is not believed to be as accurate as possible. For instance, the questions that probe an individual's behavior have the tendency to be biased by the maker of the questions (Applicants' Specification page 30. The '880 patent is believed to have substantially improved prediction for success of an individual by looking at a merger of behavior and values derived from information from the individual. But the '880 patent focused on individuals and their characteristics (Applicant's Specification page 4, line 28). In contrast, the present application pursues methodologies that instead focus on what the job requires (Applicants' Specification page 4, line 30-page 5, line 2). Further, the present application focuses on defining a job by the competencies that are most important for a job and how they relate to the job (Applicant's Specification, page 6, line 28-page 7, line 20; page 9, line 24-page 10, line 17).

Therefore, it is respectfully submitted that a *prima facie* case of anticipation based on the '880 patent has not been made. The '880 patent does not disclose the elements of Applicants' present claim 1 in the arrangement of the claim. In fact, the method of Applicants' claim 1 is looking from a very different perspective than the methodology of the '880 patent. The '880 patent is asking for information from the individual applying for the job. Applicant's present claim 1 is trying to define the job and does not ask for information from the individual. As stated

for any extension inadvertently omitted, and charge any additional fees to Deposit Account No.
26-0084.

Respectfully submitted,


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